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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Cigelske, Jr., James J.
Serial No. : 10/811,520
Filed : March 29, 2004
For : Electrical Shield for Welding Apparatus
Group Art No. : 1725
Examiner : Len Tran

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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PRE-APPEAL BRIEF CONFERENCE REQUEST

Dear Sir:

Applicant hereby requests pre-appeal review of the final rejection in the above-identified Application. The request is being filed with a Notice of Appeal. Review is requested for the reasons set forth hereinafter.

REMARKS

Claims 9-11 and 38-43 are pending in the present application. In the Final Office Action mailed April 25, 2007, the Examiner rejected claims 9-11 and 38-43 under 35 U.S.C. §103(a) as being unpatentable over Bowsky et al. (USP 5,129,843).

Applicant believes the Panel has the authority to overturn these rejections because this request relies on the fact that, through procedural errors, the Examiner has not satisfied the burden to establish a *prima facie* case of obviousness in the rejections of claims 9-11 and 38-43 under 35 U.S.C. §103(a), as numerous claim limitations are wholly absent from the applied reference. Since the errors are not simply an interpretation of the references, Applicant believes this request is proper.

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Bowsky et al. stating that “Bowsky et al discloses a plastic shield (98) for preventing arc around an electrical stud (7), made of plastic material....” *Final Office Action*, April 25, 2007, p. 2. The Examiner further stated that “Bowsky et al fail to teach the shield comprising a generally inverted U-shaped configuration” but that “Bowsky et al disclose shape and number of walls can be vary (sic) (col. 4, lines 25).” *Id.* at 2-3. Despite this failure of Bowsky to teach a generally inverted U-shaped shield, the Examiner nonetheless concluded that “it would have been obvious to [one of] ordinary skill in the art at the time applicant’s invention was made to modify the shape of the shield to conform to the arcing directions.” *Id.* at 3. Applicant respectfully disagrees with the Examiner’s assertions and believes that the Examiner has mischaracterized the teachings of Bowsky et al. and has relied upon improper hindsight in rejecting the claims.

As set forth in MPEP 2143.03, “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” As admitted by the Examiner, Bowsky et al. fails to teach a generally inverted U-shaped shield for preventing arcing from an electrical stud. *See Final Office Action*, *supra* at 2-3. Rather, Bowsky et al. discloses a terminal assembly 2 that includes conductor pins 7 and

is sealed to a wall 4 to extend into a chamber 6. *Bowsky et al.*, Col. 3, Ins. 17-21. A plastic block 8 that includes three spaced over-surface open-ended cylindrical wall shields 14 is configured to attach to the conductor pins 7. *Bowsky et al.*, Col. 4, Ins. 12-24. Each cylindrical wall shield 14 extends coextensively with and corresponds to a conductor pin 7 to minimize possible through-space arcing between the pins. *Bowsky et al.*, Col. 4, Ins. 12-24. *Bowsky et al.*, however, fails to teach or suggest that wall shields 14, which are placed about conductor pins 7, have a generally inverted U-shaped configuration as called for in claim 9.

Claim 9 specifically calls for a plurality of elements configured to form an inverted U-shaped shield. That is, claim 9 calls for a first planar side having an upper edge; a second planar side having an inner edge, the second planar side being oriented generally perpendicular to the first planar side and extending inwardly from the upper edge of the first planar side; and a third planar side oriented in a plane generally parallel to the plane of the first planar side and extending from the inner edge of the second planar side to form the inverted U-shape. Nowhere in *Bowsky et al.* is it taught or suggested that the wall shields 14 disclosed therein take the form of an inverted U-shape having the elements called for in claim 9, nor is there any suggestion or motivation provided to modify wall shields 14 to have an inverted U-shape. The mere disclosure in *Bowsky et al.* that “the shape and number of wall shields can be varied,” *Bowsky et al.*, Col. 4, ln. 25, is not enough to support the Examiner’s assertion that it would have been obvious to one of ordinary skill in the art to modify the shield in *Bowsky et al.* to achieve the inverted U-shaped electrical shield called for in claim 9. In fact, such a modification to the wall shields 14 in *Bowsky et al.* would be detrimental to the level of electrical shielding provided by wall shields 14 between conductor pins 7. That is, an inverted U-shaped shield positioned about the top conductor pin, for example, would provide less shielding between the top conductor pin and the lower two conductor pins as compared to a circular shield that completely surrounds the top conductor pin. See *Bowsky et al.*, Col. 4, Ins. 12-24; see also Figs. 1 and 2. As such, there is no reason why one would make the modification to wall shields 14 set forth by the Examiner.

As Bowsky et al. fails to teach or suggest that which is called for in claim 9, and there is no motivation to modify the teachings of Bowsky et al. to achieve that which is called for in claim 9, Applicant respectfully believes that claim 9, and the claims dependent therefrom, are patentably distinct over the cited reference. Furthermore, in addition to the failure of Bowsky et al. to teach or suggest that which is called for in claim 9, the additional elements and limitations called for in dependent claims 10-11 and 38-43 are also wholly absent from Bowsky et al.

As the elements of the inverted U-shaped shield called for in claim 9 are wholly absent from Bowsky et al. and are only taught in the present application, Applicant believes that the Examiner's modification of the cited reference to achieve the current invention is based on improper hindsight reasoning. Regarding such modification of a prior art reference (or combination of references), the court in *KSR Int'l Co. v. Teleflex Inc.* warned that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." See *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350 slip op. at 17 (U.S. April 30, 2007). Here, the Examiner uses both improper hindsight and the teaching of the present invention to assert that it would have been obvious to one skilled in the art to modify the shields in Bowsky et al. to achieve the current invention. Such motivation is improper, as "there must be some reason for the [modification] other than the hindsight gained from the invention itself..." *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). The elements of the inverted U-shaped shield called for in claim 9 are wholly absent from Bowsky et al. and are only taught in the present application. Without the teachings of the present application, the Examiner has provided no reasoning as to why it would have been obvious to one of ordinary skill in the art to modify the shape of the shield in Bowsky et al. to achieve the inverted U-shaped electrical shield called for in claim 9. As the Examiner has provided no support for these modifications, Applicant believes that the rejection of claims 9-11 and 38-43 under §103(a) is based on improper hindsight reasoning.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 9-11 and 38-43.

Applicant appreciates the Panel's consideration of these Remarks.

Respectfully submitted,

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¹The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2623. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2623. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2623. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 50-2623.